

No. 12,160

IN THE
United States Court of Appeals
For the Ninth Circuit

RALPH D. GOMEZ and WILLIAM HENDER-
SON, as individuals and co-partners
doing business under the name of
Gomez Manufacturing Company,

Appellants,

VS.

GRANAT BROS. (a corporation) and JOSEPH
GRANAT,

Petitioners-Appellees.

PETITION FOR A REHEARING ON BEHALF OF APPELLEES,
GRANAT BROS. (A CORPORATION) AND JOSEPH GRANAT.

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**PETITION FOR A REHEARING ON BEHALF OF APPELLEES,
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*To the Honorable William Denman, Presiding Judge,
and to the Honorable Associate Judges of the
United States Court of Appeals for the Ninth
Circuit:*

The appellees, Granat Bros. and Joseph Granat, herein, feeling themselves aggrieved by the opinion filed in this Court on October 20, 1949, come now and respectfully petition this Court for a rehearing. The premise of this petition is that the decision conflicts

with the rule of the cases of *Faulkner v. Gibbs*, decided in this Court October 8, 1948, 170 Fed. (2d) 34, sustained in the Supreme Court of the United States *Faulkner v. Gibbs*, No. 19, decided November 7, 1949, 83 U.S.P.Q. 192; *Ralph N. Brodie Company v. Hydraulic Press Manufacturing Company*, 151 Fed. (2d) 91; *Maulsby v. Conzevoy*, 161 Fed. (2d) 165 (9th Cir.).

As we understand the basis of the decision in the case at bar, it is that the patented device was for an exhausted combination and lacked invention in that interlocking finger rings were old in the ring art and dovetail connections were old in other arts, and that there could be no invention in combining finger rings and dovetail connections to accomplish the improved results flowing from such combination.

In line with this, this Court stated in its opinion:

“Granat did not invent nor discover the finger ring ensemble with interlocking relationship; neither did he invent nor discover the dovetail joint. He used the dovetail joint as a means of interlocking the two rings.”

The Court apparently decided that in order to impart patentable invention to a patentable combination, some one element of the combination must have been new and the result of invention or discovery. To support our interpretation of the Court's decision, we quote from it as follows:

“While the addition of a new element to an old invention may be patentable, such new element must be the result of invention or discovery

as distinguished from the exercise of mechanical skill.”

We respectfully submit that such a ruling is in conflict with the cases above set forth because as held in those cases and in all prior cases the fact that all of the elements of a claimed combination are individually old does not detract from the patentability of the combination if the combination be new. There are numerous decisions to that effect.

“* * * Conceding for the purpose of the argument, *that the elements are all old* and that each element used produces no new result, yet we are convinced that a beneficial result has been produced in a more efficient, economical and facile manner, and we feel constrained to hold the claims valid. *New York Scaffolding Co. v. Whitney*, 8 Cir., 224 F. 452.” (Emphasis ours.)

E. R. Wagner Mfg. Co. v. Porter Steel Specialties, 116 Fed. (2d) 63, 67 (C.C.A. 7, 1940).

“In discussing the validity of the patent in suit, *it may be admitted that all the elements in appellee’s structure were old in the art*. Appellee claims, however, that its structure is a new combination of these elements which produces a novel and useful result (or an old result in a more facile, economical, and efficient way). If this be true, it is sufficient to uphold the patent. *New York Scaffolding Co. v. Whitney* (C.C.A.), 224 F. 452.” (Emphasis ours.)

Young Radiator Co. v. Modine Mfg. Co., 55 Fed. (2d) 545, 546 (C.C.A. 7, 1931). (Re-hearing denied 1932.)

**THE COMBINATION IS NEW IN THE PRIOR ART
AS SHOWN BY THIS RECORD.**

The Court in its opinion, to find lack of novelty, refers to the prior art patents on finger rings which were interlocked in a manner entirely different from that shown in the patent in suit, and then goes into an entirely different art; that is, the machinery art and furniture art, to find the dovetail connection, and then from this mythical combination finds that the combination claimed in the patent is old and unpatentable. We emphasize the fact that the claims are for a combination, as can be determined from the claims themselves, and the Court, in our opinion, is in error when it finds:

“The connecting means is the element which forms the basis of defendants’ claim of invention.”

The basis of the invention is the combination of two finger rings with a particular form of dovetail connection between them so that they may be interlocked, and it is admittedly a new combination.

The Court was in error when it stated:

“In the instant case * * * the dovetail joint was well known to the art.”

There is no showing in this record of the use of a dovetail joint in connection with finger rings, or rings of any character. The prior art patents in the record showing dovetail joints do not relate to the jewelry art, but to entirely different arts, such as the furniture making art and the heavy machinery art.

We urge that there is ample evidence in the record to sustain the proposition, and as found by the District Court, that it required more than the exercise of ordinary mechanical skill to adopt the element old in one art to an entirely new art and entirely new use, to-wit, connecting finger rings.

THE DISTRICT COURT FOUND AS FACT THAT THIS NEW COMBINATION PRODUCED A MORE EFFICIENT AND BETTER RESULT, AND IN THAT THAT FINDING IS NOT CLEARLY ERRONEOUS AND IS AMPLY SUPPORTED IN THE RECORD IT SHOULD NOT BE DISTURBED IN THE ABSENCE OF A SHOWING THAT THE COMBINATION WAS OLD AND EXHAUSTED.

The District Court found as a fact that invention resided in the new combination of elements, and that finding is supported by the tremendous commercial success evidenced by the record of the finger ring ensemble here in issue.

This Court has repeatedly held, and did so recently in the *Faulkner v. Gibbs* case above cited, that the question of whether or not a new and useful combination is the result of mere mechanical skill or mere inventive faculty is one of fact and should not be set aside unless clearly erroneous.

Here the evidence shows, as a comparison of the rings in evidence with the prior art, that the new combination had considerable merit—

(1) it enabled interlocking connections between the rings which did not detract from the symmetrical

Indeed, there are numerous decisions holding that from the fact that the elements of a device are claimed as a combination it may be presumed that each of the elements individually is old in the art.

“The patent being for a combination, and no claim being made for a patent on any one of the elements, it is conclusively presumed either that they were old in the art or not patentable. *Richards v. Chase Elevator Co.*, 159 U.S. 477, 486, 16 S. Ct. 53, 40 L. Ed. 225; *City of St. Louis v. Prendergast*, 29 F. (2d) 188 (C.C.A. 8).”

Harris v. Ladd, 34 Fed. (2d) 761, at 762 (C.C.A. 8, 1929).

Our Supreme Court in the *Faulkner v. Gibbs* case above cited reaffirms this principle:

“* * * In the instant case, the patent has been sustained because of the fact of combination rather than the novelty of any particular element.”

WHERE THE COMBINATION IS MADE UP OF ELEMENTS ALL INDIVIDUALLY OLD IN THE ART, THE COMBINATION IF NEW IS PATENTABLE IF SUCH COMBINATION PRODUCES A USEFUL RESULT OR AN OLD RESULT IN A MORE FACILE, ECONOMICAL AND EFFICIENT WAY.

The above premise has been laid down in numerous decisions, including decisions of this Court.

Willard v. Union Tool Company, 253 Fed. 48.

Other authorities on this point are as follows:

“* * * So, a new combination of known devices, whereby the effectiveness of a machine is increased, may be the subject of a patent * * *.”

Cantrell v. Wallick, 117 U.S. 689, 29 L. Ed. 1017, at 1018 (1886).

“With respect to the result produced, it is not essential that it be a wholly new result, but it is sufficient if an old result is effected in a more facile, economical, or efficient way. *Galvin Elec. Mfg. Co. v. Emerson Elec. Mfg. Co.* (C.C.A. 8), 19 F. (2d) 885, 888; *Ottunwa Box Car Loader Co. v. Christy Box Car Loader Co.* (C.C.A. 8), 215 F. 362, 369; *New York Scaffolding Co. v. Whitney* (C.C.A. 8), 224 F. 452, 456; *National Hollow Brake-Beam Co. v. Interchangeable B.-B. Co.* (C.C.A. 8), 106 F. 693, 706, 707; *Skinner Bros. Belting Co. v. Oil Well Imp. Co.* (C.C.A. 10), 54 F. (2d) 896; *Grinnel Washington Mach. Co. v. E. E. Johnson Co.*, 247 U.S. 426, 432, 38 S. Ct. 547, 62 L. Ed. 1196.”

Independent Oil Well Cementing Co. v. Halliburton, 54 F. (2d) 900, 905 (C.C.A. 10, 1932), (cert. denied 286 U.S. 544, 76 L. Ed. 1281).

“The result need not be new. It is sufficient if an old result be produced in a more facile, economic or efficient way. *Willard v. Union Tool Company*, 9 Cir., 253 F. 48; *New York Scaffolding Co. v. Whitney*, 8 Cir., 224 F. 452.”

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Here the evidence shows, as a comparison of the rings in evidence with the prior art, that the new combination had considerable merit—

(1) it enabled interlocking connections between the rings which did not detract from the symmetrical

design of the rings, or from their appearance when worn separately;

(2) it enabled the rings to be connected and disconnected when on the finger, as can be clearly demonstrated from the rings in evidence;

(3) it enabled the rings to be connected by feel alone, which is important because the interlocking connections must necessarily be minute dimensions.

No one of the prior art rings has or suggests these features.

We, therefore, respectfully urge that the District Court having found as facts, which findings are based on substantial evidence and are not clearly erroneous, that

(1) the combination was new;

(2) the combination was the result of invention;
and

(3) the prior art patents did not anticipate the subject matter of the patent in suit,

they should not be disturbed in light of the authorities heretofore cited.

We, therefore, respectfully submit to the Court that its former opinion in this case is in error in the particulars above noted and in conflict with the authorities on those points laid down by this Court, and that this petition for rehearing should be granted in order that the circumstances of this case and the conflict between the opinion in this case and prior

opinions may be more fully presented to this Court for the benefit of the aggrieved parties hereto as well as in the interest of uniformity.

Dated, San Francisco, California,
November 16, 1949.

Respectfully submitted,

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CERTIFICATE OF COUNSEL

I hereby certify that the foregoing petition for a rehearing is not interposed for delay, and that in my judgment the same is well founded.

Dated, San Francisco, California,
November 16, 1949.

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